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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/654,508	09/03/2003	Geert Deroover	224105	4953

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EXAMINER

JOHNSON, CONNIE P

ART UNIT PAPER NUMBER

1752

DATE MAILED: 04/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

As

<b>Office Action Summary</b>	<b>Application No.</b> 10/654,508	<b>Applicant(s)</b> DEROOVER ET AL.	
	<b>Examiner</b> Connie P. Johnson	<b>Art Unit</b> 1752	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 January 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment***

1. The remarks and declaration filed January 17, 2006 have been entered and fully considered.
2. Claims 1-10 are presented.
3. The 112, second paragraph rejection for claim 1 is withdrawn.
4. The Obviousness-type Double Patent rejections for claims 1-10 are withdrawn.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 7 and 9 are rejected under 35 U.S.C. 102(b) as being unpatentable by Gaschler et al., U.S. Patent No. 6,238,838 B1.

Gaschler teaches a positive-working, radiation sensitive mixture which contains a hydrophilic organic polymeric binder, a coating, which is soluble in an aqueous alkaline developer and an infrared light absorbing compound (column 1, lines 9-15, 47-56). The IR compound in column 4 (Formula F5) is a cationic IR-absorbing dye and meets the limitations of instant claim 1. Gaschler also teaches that Z<sup>1</sup> and Z<sup>2</sup> of the infrared compound are preferably isopropylidene groups (-C(CH<sub>3</sub>)<sub>2</sub> -) as in instant claim 7 (column 3, lines 12-13).

Claims 1-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Gaschler et al., U.S. Patent No. 6,492,093.

Gaschler teaches recording materials comprising a substrate and a mixture with a binder layer and a positive-working IR-sensitive dye layer (column 8, lines 1-30). The IR-sensitive dyes may comprise cyanine dyes. The substrate comprises an aluminum surface that has been hydrophilized (column 8, lines 55-61). The oleophilic IR-sensitive dye layer is above the binder layer and is soluble in alkaline developer solution (column 8, lines 5-6). Examples of suitable IR-sensitive dyes include: column 4, Formula (III), column 5, Formula (IV) and column 6, Formulas (F1-F4). The substituted groups of each formula meet the limitations of instant claims 1. The solubilizing groups attached to the cyanine dyes include such anionic groups as carboxylate, sulfonate and phosphonate groups (column 4, lines 14-16). These groups are identified in the specification as solubilizing groups (page 5, lines 1-5). With regards to formulas III and IV of the reference, solubilizing groups include carboxyl and sulfo groups as in instant claim 10 (column 5, line 35). The polymeric binder in the binder layer contains acidic groups with  $pK_a$  of less than 13. This ensures that the layer is soluble in aqueous alkaline developers (column 7, lines 1-5).

### ***Response to Arguments***

Applicant's arguments filed 01/17/2006 have been fully considered but they are not persuasive. With regards to the 102(b) rejection as anticipated by Gaschler, Formula I is not representative of the IR absorbing compound in claim 1, however Formula F5 is

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representative of the compound (see current rejection). Therefore, the rejection is maintained.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Connie P. Johnson whose telephone number is 571-272-7758. The examiner can normally be reached on 7:30am-4:00pm Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 571-272-1526. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CYNTHIA A. KELLY  
SUPERVISOR  
TECH. UNIT 1752

*Cynthia Kelly*